

REMARKS

Applicant requests reconsideration and allowance of the subject patent application. Claims 37-40 have been added. Claims 1, 4, 6-7, 9-14, 16-25, and 27-40 are now pending. Support for new claims 37-40 may be found in the pending claims, as well as the specification, at, for example, pages 5-7 and FIGs. 3a-3g, & 4a-4g.

Examiner Telephone Interview

Applicant appreciates the opportunity provided by Examiner Tran to discuss the application on March 18, 2009. In the interview, the Examiner clarified her reasons for rejecting the pending claims with respect to the *Hiura* patent.

According to the understanding of Applicant's representative, the Examiner has interpreted that the content in the windows in FIGs. 2a & 2b of Applicant's specification correspond to the claimed "first GUI element" and "second GUI element." Based on this interpretation, the Examiner pointed to windows 211 & 212 of *Hiura*'s FIG. 11 for allegedly teaching the claimed "first GUI element" and "second GUI element."

In the Examiner's opinion, because both windows in Applicant's FIGs. 2a & 2b remain on a display when one of the windows is selected, *Hiura*'s windows 211 & 212 teach the claimed "GUI elements" that are "removed" and "replaced." Notably, the Examiner stated that she did not consider that menu bars 32, 34 in Applicant's FIGs. 2a & 2b could correspond to the "GUI elements."

No agreement was reached in the interview. For the reasons detailed below, it is respectfully submitted that the Examiner has misinterpreted Applicant's specification and claims.

Claim Objections

The Office Action objected to claims 23 and 27 because "computer readable medium" is allegedly not defined in the specification. The Advisory Action states "the examiner does not presume the claim term of 'computer readable medium' to be equivalent

of other terms in the spec such as "CPU, RAM or ROM." (Emphasis added.) This statement is unclear. There is no requirement that a claim term be "equivalent" to a term in the specification. (See, e.g., *Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 USPQ2d 1996, 1999-2000 (Fed. Cir. 2004); M.P.E.P. § 2173.02.)

To obviate the objection, claims 23 and 27 have been amended to recite a "computer readable data storage device." Support for this term may be found in Applicant's specification at, for example, page 4, second paragraph. Applicant respectfully requests reconsideration and withdrawal of the objection to the claims.

Objection to the Specification

The specification was objected to as failing to provide proper antecedent basis for the claimed "computer readable medium." As set forth above, Applicant has amended claims 23 and 27 to obviate the objection. Applicant, therefore, respectfully requests withdrawal of the objection to the specification.

Rejection Under 35 U.S.C. § 103(a)

Claim 1 was under 35 U.S.C. §103(a) as allegedly not being patentable over U.S. Patent No. 6,628,310 to Hiura et al. ("*Hiura*") in view of U.S. Patent No. 6,957,395 to Jobs et al. ("*Jobs*").¹ Applicant traverses the rejection of claim 1.

The Examiner Has Misinterpreted Applicant's Specification

Based on the Examiner's comments in the above-described telephone interview, the Examiner has misinterpreted Applicant's specification. To assist the Examiner, an explanation of the specification is provided below.

FIGs. 2a-5 illustrate an exemplary embodiment that is broadly encompassed by Applicant's claim 1. The figures show a menu bar that undergoes an animated transition

¹ The Office Action contains statements characterizing the claims and related art. Regardless of whether any such statements are specifically addressed herein, Applicant's silence as to these characterizations should not be construed as acceptance of them.

when a user selects a window to make an application active, thereby aiding the user in recognizing that menu bar choices associated with the application may have changed. (Applicant's specification, p. 2, 7-29 and FIGs. 2a, 3a-3g, and 2b).

In Figure 2a, a word processing application ("Microsoft Word") associated with "Document2" is active. (*Id.* at FIG. 2a and p. 5, 6-22.) The word processing application is also associated with a first menu bar 32, which includes a variety of menu choices (including, e.g., "Format," "Tools," "Table"). (*Id.*)

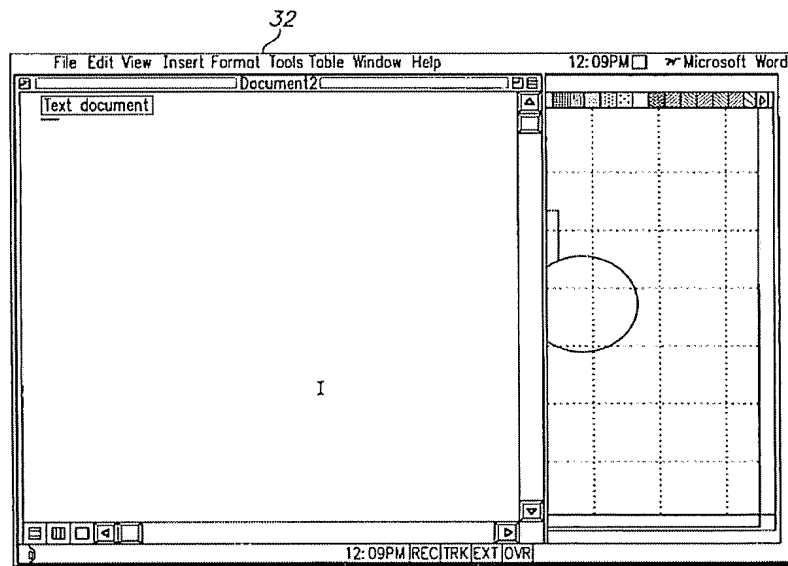


FIG. 2a

Next, as shown in FIG. 2b, when a document ("Untitled Layer 1") associated with a drawing application ("MacDraw Pro") is selected by an associated window, the first menu bar 32 is changed to a second menu bar 34, which has different menu choices (including, e.g., "Layout," "Arrange," "Pen"). (*Id.*)

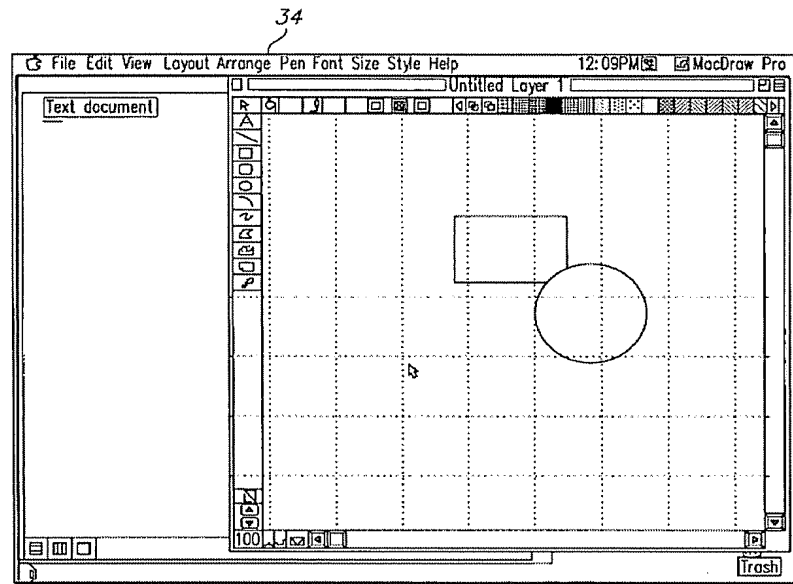
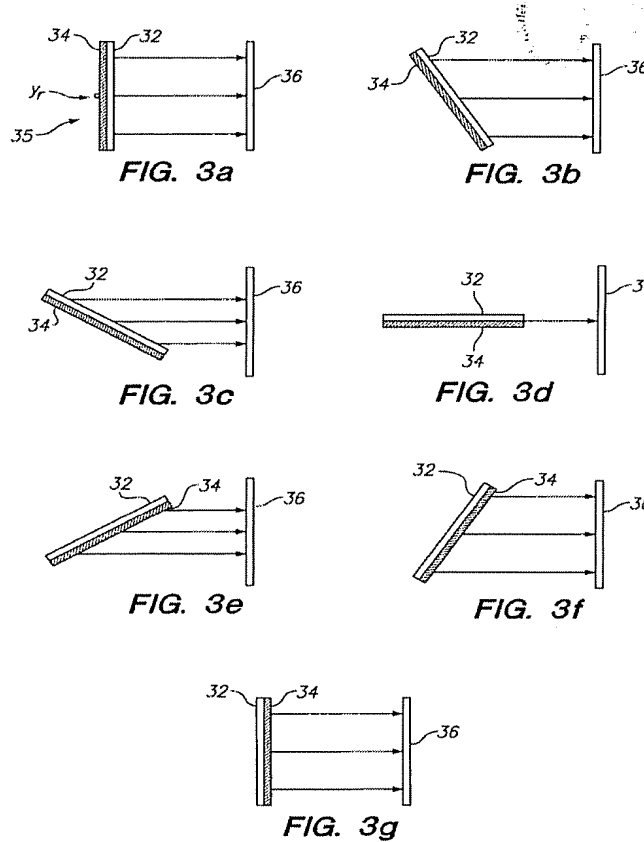


FIG. 2b

Because it may be difficult for a user to recognize the transition between menu bar 32 and menu bar 34, the exemplary embodiment provides an animation during menu bar transitions. (*Id.* at p. 6, ll. 12-34.) As such, the user can immediately recognize that a change in the menu bar has taken place and that, consequently, a different application has been brought to the foreground of the display. (*Id.*)

Figures 3a-g illustrate a non-limiting example of the animated transition between menu bars 32 & 34. (*Id.* at p. 7, l. 24 – p. 9, l. 8.) As shown, the menu bars 32 & 34 appear to rotate about an axis such that menu bar 32 is removed from display area 36 and replaced by menu bar 34. (*Id.*)



Turning to the Office Action, the Examiner's rejection relies on a notion that *Hiura*'s process illustrated in FIG. 11 is "exactly the same" as that illustrated in FIGs. 2a & 2b of Applicant's disclosure. (Office Action, p. 8.) The Examiner asserts, "*Although application 32 is removed from the computer display and replaced by the application 34, the application 32 remains on the computer display. The application 32 just becomes inactive but [is] still displayed on the computer screen.*" (Office Action, p. 8, emphasis added.) The Examiner has read the Applicant's disclosed menu bar 32 and menu bar 34 to be "application 32" and "application 34." This is incorrect.

Nowhere does Applicant's specification describe menu bars 32 & 34 as "applications." The specification describes a "menu bar" as follows:

A menu bar is a portion of the computer display of the GUI, e.g. at the top of the screen, within which several menu options are presented to a user. When the menu is activated, usually by

"pointing and clicking" with a mouse, a pull-down menu appears below a menu item in the menu bar. (Applicant's specification, p. 1.)

Referring now to FIGS. 2a-2b, two menu bars 32, 34 are illustrated, which are associated with different applications. In FIG. 2a, a first menu bar 32 is illustrated having a variety of menu options associated with the word processing application that is currently active (i.e., the application controlling the text document in the foreground). When the document associated with the drawing application is brought to the foreground by selecting the window associated therewith (e.g., by a user-initiated event, such as a mouse click event, or the like), the first menu bar 32 is changed to a second menu bar 34, which has different menu choices. (*Id.* at p. 5, emphasis added.)

As described above, menu bars 32 & 34 are associated with applications. As such, menu bars 32 & 34 in Applicant's figures cannot be considered "applications" as asserted in the Office Action.

In addition, as described in the exemplary embodiment above, the windows in FIGs. 2a & 2b are not removed or replaced from the display. (See *supra*.) Indeed, in the above-described exemplary embodiment, the application window remain on the display while menu bar 32 transitions to menu bar 34. (See FIGs. 2a-3g.)

For at least the two reasons above, the Examiner has misinterpreted Applicant's specification. Applicant respectfully submits that, based on this misinterpretation, the Examiner has misconstrued the features recited in Applicant's claim 1.

*The Applied References Do Not Disclose or
Suggest the Subject Matter Recited in Claim 1*

Hiura does not disclose or suggest "removing from the computer display the first GUI element ... and replacing the first GUI element with the corresponding, second GUI element," as recited in present claim 1. (Emphasis added.) The Office Action and Advisory Action point to FIG. 11 for purportedly disclosing this feature. FIG. 11 shows an active window 211 of one application being turned-over to reveal inactive window 212 of another application. The Examiner asserts that window 211, window 212 correspond to the claimed "first window" and "second window," respectively. (Office Action, p. 7.) In addition, the

Examiner asserts that the content in each of these windows correspond to the claimed "first GUI element" and "second GUI element."

To the contrary, the content of window 211 is not removed from screen 15. Only a portion of window 211 and its content are turned-over on screen 15 to unveil a portion of window 212. (*Hiura*, col. 10:63-67.) Indeed, it appears that the Examiner recognizes that windows 211 & 212 are "still displayed on the computer screen." (Office Action, pp. 7-8, emphasis added.) Given that the window remains displayed on screen 15, neither window 211 nor its content can be considered removed from screen 15. *Hiura*, therefore, does not disclose or suggest, "removing from the computer display the first GUI element," as recited in claim 1. (Emphasis added.)

In addition, because the Examiner recognizes that window 211 and/or its content remains on screen 15, it is improper to interpret it to be ""remov[ed] from the computer display," as recited in claim 1. (Emphasis added.) As the Examiner is aware, claim terms should be given their broadest reasonable construction in light of the specification. (M.P.E.P. § 211.01(I), *citing In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).) Applicant respectfully submits that the Examiner's interpretation of "removing" to mean "remaining" is contrary to the ordinary meaning of the claim term.

Furthermore, the content of window 211 and 212 are entirely unrelated. Windows 211 & 212 could be any content and be located anywhere on screen 15. Also, the content of windows 211 and 212 have no relationship. Thus, the content of window 211 cannot be considered to be "corresponding" to the purported object in window 212. *Hiura*, therefore, does not disclose or suggest, "a first graphical user interface (GUI) element ... and a corresponding second graphical user interface (GUI) element" or "removing ... and replacing the first GUI element with the corresponding, second GUI element," as recited in claim 1. (Emphasis added.)

The Final Office Action and the Advisory Action do not address the above-noted features. These responses also do not answer Applicant's arguments with regard to these features. (See Advisory Action, p. 2.) It is respectfully requested that in any subsequent Office Action rejecting claim 1, the Examiner explain how the cited references are believed to teach or suggest these features.

The Examiner looks to *Jobs* to overcome *Hiura*'s deficiencies. *Jobs*, however, is not relied on for disclosing or suggesting the above-noted features of claim 1 missing from *Hiura*. Thus, for at least this reason, the Office Action fails to establish a *prima facie* case that claim 1 is not patentable over the purported combination of *Hiura* and *Jobs*.

Hiura and Jobs Cannot Be Properly Combined to Result in the Claimed Subject Matter

In addition, the Examiner has conceded that *Hiura* does not disclose or suggest, the claimed “detecting, when the first application is active, user selection of the second window to make the second application active.” (Office Action, p. 4, emphasis added.) As such, *Hiura* also fails to disclose or suggest, “in response to detecting the user selection of the second window, providing visual notification of the replacement of the first GUI element with the second GUI,” as recited in claim 1. (Emphasis added.)

The Examiner looks to *Jobs* to overcome this deficiency. Applicant respectfully submits, however, that, the proposed combination of *Hiura* and *Jobs* is improper because the references cannot be predictably combined without changing their principle operations. (*In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); M.P.E.P. § 2143.01(VI).)

Jobs discloses:

a user-selectable mode of operation in which only a single window, or at most a few windows, associated with the currently active task is displayed on the computer monitor. All other windows relating to non-active tasks are minimized by reducing them in size or replacing them with a representative symbol, such as an icon or a menu item, so that they occupy a minimal amount of space on the display screen. When a user switches from the current task to a new task, for example by selecting a minimized window, the window associated with the current task is automatically minimized as the window pertaining to the new task

is returned to an enlarged state. As a result, the user is only presented with the window that relates to the current task of interest, and clutter provided by nonactive tasks is removed. (*Jobs*, cols. 134-2:12, emphasis added.)

Jobs discloses automatically minimizing a window associated with a current task when a user switches tasks. Thus, at best, *Jobs* might suggest modifying *Hiura* to minimize a top window, to provide a view of the lower window. But doing so is contrary to the purpose of *Hiura*, which is to allow a user to peek behind a top window to view a lower window, while both windows remain displayed (i.e., unminimized). As such, the proposed modification of *Hiura* based on *Jobs* would render *Hiura's* method inoperable for its intended purpose. Accordingly, the proposed combination of *Hiura* and *Jobs* is improper. As such, for this additional reason, the Office Action fails to establish a *prima facie* case that claim 1 is not patentable over the purported combination of *Hiura* and *Jobs*.

For all the reasons above, the purported combination *Hiura* and *Jobs* do not disclose or suggest the subject matter recited in Applicant's claim 1 and cannot be properly combined. Accordingly, *Hiura* and *Jobs* cannot support a *prima facie* case for rejecting claim 1 under Section 103(a). Claim 1 is, therefore, allowable over the purported combination of *Hiura* and *Jobs*. Claims 4, 6, 7, 9-13 and 24 are also allowable at least due to their dependence from claim 1.

Claims 14, 23, 28, 31 and 34, although of different scope than claim 1, recite subject matter similar to that recited in claim 1. Thus, claims 14, 23, 28, 31 and 34 are allowable over *Hiura* and *Jobs* for similar reasons to those set forth above with regard to claim 1. Claims 16-22, 24, 25, 27, 39, 30, 32, 33, 35 and 36 are allowable due to their corresponding dependence from claims 14, 23, 28, 31, 34 and 37.

New Claims

New claim 37, although having a different scope than claim 1, recites similar subject matter to that recited in claim 1. Thus, claim 37 is allowable over the applied references for similar reasons to those set forth above with regard to claim 1, in addition to reciting other

allowable subject matter. Claims 37-40 are also allowable at least due to their dependence from claim 37.

Conclusion

For the reasons set forth above, Applicant respectfully requests allowance of the pending claims.

If additional fees are required for any reason, please charge Deposit Account No. 02-4800 the necessary amount.

Respectfully submitted,

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